

Application No. 10/667,921
July 20, 2006
Page 3

BI9100CIPCON

Proposed Amendments to the Drawings

Please see the attached proposed Replacement Sheet, which modifies FIG. 11c.

Application No. 10/667,921
July 20, 2006
Page 17

BI9100CIPCON

REMARKS

Applicants have amended claims Claims 38, 54 and 70-75 are presently pending in the application.

The Office Action objected to the February 8, 2006 Amendment under 35 U.S.C. 132(a) for allegedly introducing new matters into the disclosure. Specifically, the new matter is alleged to be as follows: the relationship between the imaging device, the cannula, and the additional tube illustrated in the new figure(s); the incorporation by reference of the disclosure of applications other than 09/188,072; the inclusions of 60/064,465 in the continuing data; and the limitation that obstructions are not present between the cannula lumen and an area of tissue located distally of the open cannula distal end. Applicants have addressed each of these issues with the present submission; it is noted that the first paragraph of the present application incorporates by reference the disclosure of U.S. Application No. 09/188,072.

The Office Action also rejected claims 27-69 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, according to Examiner Shay, the phrase "obstructions are not present between the cannula lumen and an area of tissue located distally of the open cannula distal end" cannot be found in the original disclosure. In response, Applicants refer the Examiner to Figures 9b and 10b of the present application and the statement in the specification that in those figures "the tissue remover 110 is configured to have an open cannula configuration." In contrast, each of the cannula distal ends of the Massengill patent have porous or ribbed obstructions. Clearly, one of ordinary skill in the art viewing Figures 9b and 10b of the present application would understand the open cannula ends to be free of obstructions, since they are wide open. According to Section 2125 of the Manual of Patent Examining Procedure (MPEP), which speaks on an analogous issue of the interpretation of prior-art drawings, the drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. This same section of the MPEP cites to a case which states that, while patent drawings do not define the precise proportions of the elements ... the description of the article pictured can be relied on, in combination with the

Application No. 10/667,921
July 20, 2006
Page 18

BI9100CIPCON

drawings, for what they would reasonably teach one of ordinary skill in the art. The above language from Applicants' specification clearly identifies the structure that corresponds to the open cannula distal end as that depicted in Figures 9b and 10b which clearly is not obstructed. Applicants thus submit that the queried language is disclosed in the as-filed application. Applicants respectfully submit that in this and the other instances discussed herein the drawings are relied upon to show exemplary embodiments of the invention such as are consistent with, for example, recitations in the current claims. Using the proper standard for evaluating what the drawings disclose, which is what they reasonably disclose and suggest to one of ordinary skill in the art, the queried elements are clearly disclosed, evidencing that Applicants had possession of the claimed invention.

The following claims were rejected based upon prior art: claims 27-53, 55-64, 67, 68 and 70-75. In particular, claims 27-53, 60-64 and 70-74 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rizoiu et al. (International Publication No. WO97/07928) in combination with Massengill (U.S. Patent No. 6,106,516); and claims 55-59, 67-69 and 75 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rizoiu et al. in combination with Massengill as applied to claims 27-53, 60-64 and 70-74 and further in view of Kittrell et al. (U.S. Patent No. 4,913,142). Applicants respectfully traverse these rejections as they relate to the claims even before the present amendment but especially after the entering of this amendment. Regarding the outstanding obviousness rejections, it is well established that a claim can be rejected on obviousness grounds only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior-art reference or combination of prior-art references. Thus, for a rejection under 35 U.S.C. 103(a) to be proper, every limitation recited in a claim, which is rejected as being obvious in view of a combination of prior-art references, must be disclosed or taught in that collection of prior-art references. In the instant case, Applicants reiterate that the cited references neither disclose nor suggest each and every element that is recited in any of the rejected claims. Since certain claim limitations are not disclosed or suggested by any of the prior art references, combinations of the prior art references still do not contain the missing limitations.

Application No. 10/667,921
July 20, 2006
Page 19

BI9100CIPCON

Thus, regarding the standard that each and every claimed element must be shown or taught somewhere in the combination of relied-upon references of a rejection, the relied-upon references, taken separately or together, do not appear to disclose or suggest any of Applicants' claimed combinations. In particular, as examples, none of the prior art references disclose or suggest Applicants' claimed combinations including, among other things, "obstructions ... not present between the cannula lumen and an area of tissue located distally of the open cannula distal end ... whereby the expanding atomized fluid particles do not contact portions of the aspiration cannula disposed distally of the cannula lumen" (emphasis added), "an unobstructed, open cannula distal end ... to receive ... tissue therein ... impart disruptive cutting forces onto soft or hard tissue within the cannula lumen" (emphasis added), and a cannula distal end "not obstructed and ... adapted to receive ... into the cannula lumen ... impart disruptive cutting forces onto soft or hard tissue within the cannula lumen" (emphasis added), as recited in the respective independent claims 27, 38 and 54.

Also, the prior art references of record, taken separately or together, do not disclose or suggest, among other things, a method "whereby soft or hard tissue is drawn into the cannula lumen through the tissue aspiration inlet port ... [followed by] causing the portion of atomized fluid particles to expand and impart disruptive cutting forces onto the area of tissue within the cannula ... and providing a source of aspiration at a proximal end of the aspiration cannula" (emphasis added) as recited in claim 70; a tissue remover, comprising, among other things, structure "to draw soft or hard tissue through the tissue aspiration inlet port and into the cannula lumen ... [and] causing the portion of atomized fluid particles to expand and impart disruptive cutting forces onto soft or hard tissue within the cannula lumen" (emphasis added) as set forth in claim 71; the combination of elements of claims 72 and 75 including, among other things, an imager, a fluid router to generate fluid particles in "an interaction zone located distally of the distal end ... to transmit the electromagnetic energy beyond the distal end and into a portion of fluid particles in the interaction zone ... causing the portion of fluid particles to expand and impart disruptive cutting forces onto soft or hard tissue" (emphasis added) and "an interaction zone located distally of the distal end ... the electromagnetic energy exiting ... at a point outside of the cannula distal end ... causing the portion of fluid particles distal of the distal cannula end

Application No. 10/667,921
July 20, 2006
Page 20

BI9100CIPCON

to expand and impart disruptive cutting forces onto soft or hard tissue” (emphasis added); a method including, among other things, “generating atomized fluid particles in an interaction zone located distally of the cannula distal end ... transmitting the electromagnetic energy ... out of the cannula distal end and into the interaction zone ... [and] causing the portion of atomized fluid particles to expand and impart disruptive cutting forces ... outside of the cannula distal end ” (emphasis added) as recited in claim 73; and a tissue remover, comprising, among other things, a fluid and energy guide “to generate atomized fluid particles in an interaction zone located distally of the cannula distal end ... electromagnetic energy exiting the fluid and energy guide at a point outside of the cannula distal end and ... atomized fluid particles in the interaction zone ... causing the portion of atomized fluid particles to expand and impart disruptive cutting forces onto soft or hard tissue” (emphasis added) as set forth in claim 74.

The Examiner has not pointed to any combinations of references which would be combinable to yield any of the currently claimed combinations. Applicants therefore submit that the pending independent claims would not have been obvious at the time of the invention to one of ordinary skill in the art and patentably distinguish over the prior art of record. Moreover, it is respectfully submitted that the pending dependent claims are patentable at least because of their dependencies on the mentioned independent claims. Accordingly, it is respectfully submitted that the outstanding rejections under 35 U.S.C. § 103(a) are improper. Applicants respectfully request that the Examiner reconsider and withdraw these rejections.

Application No. 10/667,921
July 20, 2006
Page 21

BI9100CIPCON

Applicants respectfully submit that the application is now in condition for allowance, and an early indication of the same is requested. The Examiner is invited to contact the undersigned with any questions.

Respectfully submitted,



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